

Application No. 10/805,864  
Amdt dated: October 22, 2007  
Reply to Office action of July 20, 2007

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office action of March 8, 2007. Claims 1-28 and 36-44 are pending in the application. Claims 29-35 are canceled without prejudice and/or disclaimer. Claims 1, 6, 15 and 23 have been amended. New claims 36-44 have been added.

#### **Claim Rejection – 35 USC §102**

Also, on page 3 of the action, claims 1-4, 12-14, 23, 25-26 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoon (U.S. Patent Number 5,707,362). Applicant respectfully traverses this rejection.

**Independent claim 1** as amended provides that the elongate tubular body has a lumen extending between the proximal end and the distal end and a tip is connected to and disposed at the distal end of the tubular body for penetrating through a body wall and into the body cavity. The tip in a first, penetrating position, blocks the lumen of the elongate body and the tip swings from the first, penetrating position to a second, retaining position, the tip swinging away from the elongate body unblocking the lumen of the elongate body, when the body wall has been traversed.

The action indicates that Yoon discloses “an elongate tubular body 60 and a tip 42 which moves from a first penetrating position to a second, retaining position once the body wall has been traversed C2 L25-37.”

Yoon, in col. 5, line 64 to col. 6, line 5, does describe that the “portal unit 22 includes an elongate portal sleeve, cannula or catheter 26, a middle member 32 disposed in portal sleeve 26 and a housing 28 mounting proximal ends of the portal sleeve and the middle member. Portal sleeve 26 defines a lumen for receiving a penetrating member of penetrating unit 24 and is made up of a body 30 terminating

distally at a distal end 34 and proximally at a proximal end 38 secured to a front wall 36 of housing 28.”

Yoon, in col. 6, lines 38-43, also describes middle “member 32, which carries expandable portion 42, terminates distally at a distal end 46 and proximally at a transverse flange 50 disposed in housing 28. Middle member 32 is disposed in portal sleeve 26, and the portal sleeve and the middle member are secured to one another distally of expandable portion 42. As shown in FIG. 1, the middle member distal end 46 is aligned or substantially aligned with the portal sleeve distal end 34, and the portal sleeve and the middle member are secured to one another at the distal ends 34 and 46.” As such, the expandable portion 42 is on the middle member 32 that is secured to the portal sleeve 26.

Yoon, in col. 8, lines 56-60, further describes that the “penetrating unit 24 includes an elongate penetrating member 60 for being received in the lumen of portal sleeve 26 and having a proximal end mounted by a hub 64, a distal end 86 having a sharp tip or point 66 and a shaft or body extending between the proximal and distal ends.” Thus, the elongate penetrating member 60 is inserted into the lumen of the portal sleeve 26. The expandable portion 42 is not connected to the elongate penetrating member 60.

Thus, Yoon does not describe that a tip is connected to and disposed at the distal end of the tubular body for penetrating through a body wall and into the body cavity. The tip in a first, penetrating position, blocks the lumen of the elongate body and the tip swings from the first, penetrating position to a second, retaining position, the tip swinging away from the elongate body unblocking the lumen of the elongate body, when the body wall has been traversed as provided in claim 1 and thus Yoon cannot anticipate claim 1. Accordingly, claim 1 is believed to be patentable. Since claims 2-28 depend from claim 1, and contain additional limitations that are patentably distinguishable over the references of record, claims 2-28 are also believed to be

patentable. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Regarding **claims 3-4, 12-14, and 25-26**, the action indicates that the tip can be solid or hollow, sharp, pointed or bladed 66 or is substantially blunt or has a conical surface, See Fig. 23, C25 L4-35, wherein the conical surface has at least one tissue engaging helical raised pattern on the surface, See Fig. 21. The tip can make a small skin incision and because of its conical structure separates the different layers of the body wall with a reduced penetration force.

However, the tip described in Yoon, e.g., Fig. 23, C25, L4-35 or Fig. 21, are tips for the penetrating member, e.g., penetrating members 960 or 760. These tips are not the same expandable portion 42 (tip 42) as referenced by the action that moves from a first penetrating position to a second, retaining position once the body wall has been traversed. As such, the tips provided for in claims 3-4, 12-14 and 25-26 are not described by Yoon and thus Yoon cannot anticipate these claims.

Additionally, since claims 3-4, 12-14 and 25-26 depend from claim 1, these claims incorporate the elements of claim 1. For example, none of these tips swing or are connected to the elongate tubular body as provided in claim 1. Thus, the tips provided in claims 3-4, 12-14 and 25-26 are not described by Yoon and thus Yoon cannot anticipate these claims. Accordingly, claims 3-4, 12-14 and 25-26 are believed to be patentable.

Regarding **claim 23**, claim 23 is placed in independent form, incorporating the original non-amended base claim 1 and intervening claim 4. As noted above, the tip described by Yoon in FIG. 21 is part of the penetrating member and are not part of the portal sleeve or the expandable member 42. Accordingly, Yoon does not describe a tip disposed at the distal end of the tubular body for penetrating through a body wall and into the body cavity, wherein the tip moves from a first, penetrating position to a second,

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retaining position when the body wall has been traversed, wherein the tip is substantially blunt or has a conical surface, wherein the conical surface has at least one tissue engaging helical raised pattern on the surface as provided by claim 23. Thus Yoon cannot anticipate independent claim 23 and hence claim 23 is believed to be patentable. However, if a new rejection is needed, Applicant requests a non-final action as the amendment merely places Claim 23 in independent form, such an amendment does not necessitate such a new rejection to make the action Final. (See MPEP 706.07(a)).

#### **Claim Rejections – 35 USC §103**

On page 3 of the action, claims 5-11, 17-22 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon in view of Taylor et al. (U.S. Patent Number 5,279,564). On page 4 of the action, claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon in view of Richard (U.S. Patent Number 6,383,195). Also, on page 4 of the action, claims 24 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon in view of Farley et al. (U.S. Patent Number 5,372,599). Applicant respectfully traverses these rejections.

For the reasons stated above with reference to claim 1 and since claims 5-11, 15-22, 24 and 27-28 depend from claim 1, and contain additional limitations that are patentably distinguishable over the references of record, these claims are also believed to be patentable.

New **claims 36-44** describe other aspects of the invention. For example, new **claims 36-37** describe that the tip has a rounded centering portion extending from a proximal end of the tip and into the distal end of the elongate tubular body and that a circumference of the rounded centering portion is equal to an inner circumference of the elongate tubular body. **Claim 38** describes that the tip has a plurality of proximally facing extensions dimensioned to fit into distally facing slots outlining an outer periphery

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of the tubular body. **Claim 39** describes that the retention member is fitted into the wall of the elongate tubular body and extends into the tip on one side of the tip that opposes the one of the plurality of proximally facing extensions and a remaining plurality of proximally facing extensions positioned therebetween. **Claims 40-41** describes that the tip in the first, penetrating position blocks passage of an opening at the distal end of the elongate tubular body preventing passage of surgical instruments through the elongate tubular body and the tip in the second, retaining position, unblocks passage of the opening at the distal end of the elongate tubular body allowing passage of surgical instruments through and out the tubular body. New **claim 42** provides that the tip is a non-expanding tip. New **claim 43** describes that the tip is a non-compressible tip. New **claim 44** describes that the tip is a single-piece tip.

The cited references do not describe or suggest such a surgical access port with the recited features in new claims 36-44. Also, since claims 36-44 depend from an associated independent claim 1 and thus incorporate the features recited in corresponding claim and contain additional limitations that, when considered as a whole are patentably distinguishable over the references of record, claims 36-44 are believed to be patentable.

### **Conclusion**

In view of the foregoing remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, reconsideration of the application and allowance of claims 1-28 and 36-44 are respectfully requested. If the Examiner should have any remaining questions or objections, a telephone interview to discuss and resolve these issues is respectfully requested.

Furthermore, Applicant respectfully submits that the features, e.g., tip or elongate tubular body, described in this response are merely exemplary and/or illustrative and does not disavow any claim scope or define any elements or terms in the claims in such a way other than as recited or provided in the claims and their

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equivalents. Likewise, any characterization of the features, e.g., tip or elongate tubular body, in relation to the claims are merely exemplary and/or illustrative and thus Applicant does not disavow any claim scope or specially define any elements or terms in the claims in such a way other than as recited or provided in the claims and their equivalents.

Sincerely

APPLIED MEDICAL RESOURCES

BY



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